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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/541,354

06/21/2006

Jorn Bullerdiek

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EXAMINER

SHEN, WU CHENG WINSTON

ART UNIT

PAPER NUMBER

1632

MAIL DATE

DELIVERY MODE

12/22/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/541,354	<b>Applicant(s)</b> BULLERDIEK, JORN	
	<b>Examiner</b> WU-CHENG Winston SHEN	<b>Art Unit</b> 1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 4-91 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This application 10/541,354 is a 371 of PCT/EP04/00030 01/05/2004.

#### ***Election/Restriction***

Applicant's election with traverse of Group II, claims 1 and 3, drawn to “use claim” that was interpreted as, for restriction purpose, a method of using the *translation product(s)* thereof one or several nucleic acid(s) in a process, whereby the process is selected from the group comprising angiogenesis, neovascularization, transmyocardial revascularization, wound healing, angiogenesis following wounding, epithelialization and healing of tooth and bone implants, whereby the nucleic acid(s) is/are one(s) that code(s) for high mobility group (HMG) proteins, including HMGB 1 or a part thereof, in the reply filed on 09/18/2008 is acknowledged. In response to further restriction documented on page 12 of the Elections/Restriction mailed on 06/18/2008, Applicant elected the process of angiogenesis. Applicant does not provide any ground(s) of traversal. Thereby, the traversal is not found persuasive. The Examiner notes that Group II (claims 1 and 3) are written as “use claims”, and for Election/restrictions purpose, the “use claims” have been interpreted as “a method of using” (See page 2 of the Elections/Restrictions mailed on 06/18/2008)

It is noted that in the reply filed on 09/18/2008, Applicant states the election of “Group II (claims 1-3)”. However, as indicated in the Elections/Restriction mailed on 06/18/2008, claim 2 belongs to both Group III and Group IV, not to the elected Group II.

Art Unit: 1632

Accordingly, claims 2 and 4-91 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim.

Claims 1-91 are pending. Claims 1 and 3 are currently under examination.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejection - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1 and 3 provides for the use of translation products of nucleic acid(s) comprising genes encode for the high mobility group (HMG) proteins , but, since the claim does not set forth any steps involved in the method/process (angiogenesis as elected process), it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

***Claim Rejection - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 1632

2. Claims 1 and 3 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by **Bianchi et al.** (US 2004/0136979, publication date 07/15/2004, filed on 03/16/2001).

Bianchi et al. teaches the use of HMG box-binding molecules and molecules having sequences homology with HMG box for reparation of therapeutic agents for treatment of vascular diseases, which reads on the process of angiogenesis. Bianchi et al. teaches HGMB1 and/or HMGB1 fragments corresponding to the HMG box, HMG box domains of other proteins belonging to HMG-box family and other proteins of the HMG-box family are useful in the preparation of therapeutic agents which facilitate and/or induce connective tissues regeneration (See paragraph [0096] and [0097], Bianchi et al.).

Art Unit: 1632

Thus, Bianchi et al. clearly anticipates claims 1 and 3 of instant application.

### *Conclusion*

4. No claim is allowed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication from the examiner should be directed to Wu-Cheng Winston Shen whose telephone number is (571) 272-3157 and Fax number is 571-273-3157. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the Supervisory Patent Examiner, Peter Paras, Jr. can be reached on (571) 272-4517. The fax number for TC 1600 is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

Application/Control Number: 10/541,354

Page 6

Art Unit: 1632

would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Wu-Cheng Winston Shen/

Patent Examiner

Art Unit 1632